

Appl. No. : 10/020,507  
Filed : December 11, 2001

### REMARKS

Applicant wishes to thank Examiner Nguyen for the telephone interview with Sean Kavanaugh, Esq., that occurred on May 4, 2004. The Interview Summary, pursuant to M.P.E.P. §713.04 is summarized as follows:

*Attendees, Date and Type of Interview:* The telephone interview was conducted on May 4, 2004 and attended by Sean Kavanaugh, Esq. of Intrinsic Therapeutics, Inc. and Examiner Victor Nguyen.

*Exhibits and/or Demonstrations:* No exhibits or demonstration were shown.

*Identification of Claims Discussed:* Claims 1 and 18 were discussed.

*Identification of Prior Art Discussed:* U.S. Patent No. 6,491,690 was discussed.

*Proposed Amendments:* No proposed amendments were discussed.

*Principal Arguments and Any Other Pertinent Matters:* Clarification of the elements disclosed in U.S. Patent No. 6,491,690 was discussed.

*Results of Interview:* No agreement on the claims was reached.

### Rejection Under 35 U.S.C. § 102(e)

Claims 1-8 and 18-23 are pending in the application. The Examiner rejected Claims 1-8 and 18-23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,491,690 to Goble et al ("Goble"). According to the Examiner:

Goble et al disclose a surgical instrument having all of the limitations as recited in the above listed claims, including: an advancer or a rod (14) is coupled to a probe (12b) that is housed within a cannula (10). The probe member has a proximal end connected to the advancer and a distal end connected to a probe tip (12, fig 10) Examiner considers item 20 teaches a curved passage within the distal end of the cannula which engages item 12b to force the active electro outward. Furthermore, the passage 28 is pushed around the inner surface of the passage 20 in order to remove the debris there; and wherein the probe member travels through the passage at an angle between 30 and 150 degrees (see fig 10 col. 17 line 13-30).

The text in the Goble specification that the Examiner appears to have relied upon for his rejection is as follows:

It would also be possible to introduce axial motion during rotation. Thus, for the electrode unit E4, the simple 90° hook form active electrode 12 can rotate on a bearing surface provided by the distal end face of the ceramic tube 18, this end face being provided with ratchet teeth features. Thus, as the rod 14 rotates, the hook-shaped end portion 12a moves in and out as it engages and disengages the ratchet

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teeth, this axial movement being permitted by the off-set flexible drive rod 14 repeatedly elongating and shortening. ('690 Pat. col. 17 lines 13-30).

To anticipate a claim, the reference *must teach every element of the claim*. According to the M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). M.P.E.P. § 2131 also expressly provides that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Applicant's Claims 1 and 18 expressly recite the angle at which the probe travels with respect to the cannula. For example, Claim 1 recites "a curved passage within said distal end of said cannula wherein said probe member travels through said passage and may be advanced outward therefrom *at an angle between 30 and 150 degrees with respect to the longitudinal axis of the cannula.*" There is simply no teaching or suggestion in Goble to extend the probe in a direction that is angled away from the cannula.

Indeed, Goble is directed only to a rotating probe. Goble merely teaches the rotation of the probe/rod with a hooked tip resting on the ratcheted or serrated edged mouth of the cannula to impart axial motion on the probe, i.e., *Goble's probe rotates within the cannula and only moves in and out (shortens and elongates)*. The probe in Goble does not extend angularly, and there is no passageway or deflection surface to accommodate such an angular extension. Goble simply discloses an "active electrode 12 can rotate on a bearing surface provided by the distal end face of the ceramic tube 18, this end face being provided with ratchet teeth features. Thus, as the rod 14 rotates, the hook-shaped end portion 12a moves in and out as it engages and disengages the ratchet teeth...". Goble, col. 17, lines 15-19.

Applicant's Claim 1, as amended, expressly recites a passage that "restricts travel of the of probe with respect to the horizontal axis of the cannula *thereby preventing rotation of the probe.*" Applicant's Claim 18, as amended, expressly recites a deflection surface, a passage adjacent to the deflection surface, *wherein the passage restricts movement of the probe in a non-angular direction*. Thus, both Claim 1 and Claim 18 expressly recite the angular deflection of

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the probe relative to the cannula. Goble does not teach or suggest this angular deflection, and cannot be used to anticipate Applicant's claims.

Accordingly, Applicant respectfully submits that Claims 1 and 18, as amended, are allowable over the cited art. Claims 2-8 and 19-23 are also allowable because they depend from an allowable claim base and because they recite independently patentable features. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 102(e).

In view of the foregoing remarks, Applicant respectfully asserts that the present application is fully in condition for allowance. If any matters should remain, the Examiner is invited to contact the undersigned at the telephone number provided below. No fees are believed due. However, please charge any fees, including any fees for additional extensions of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 21, 2004

By: 

Salima A. Merani

Recognized under 37 CFR § 10.9(b)

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